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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,029

02/03/2004

Charles Eglinton

011-305

2028

29569

7590

12/10/2008

FURR LAW FIRM
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EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

12/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/708,029	Applicant(s) EGLINTON, CHARLES	
	Examiner NATHAN C. UBER	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 28 August 2008.
2. Claims 1-20 have been canceled.
3. Claims 21-31 have been added.
4. Claims 1-20 are currently pending and have been examined.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "115" has been used to designate *tier 1 affiliates*, *tier 2 affiliates* and *affiliate*. This objection is maintained because it was not addressed by Applicant.
6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "120" and "160" have both been used to designate *clearinghouse* (see ¶0107). This objection is maintained because it was not addressed by Applicant.
7. The drawings were objected to as failing to comply with 37 CFR 1.84(p)(5) because they did not include the following reference signs mentioned in the description: *product 145*, *automated registration system 150* and *advertiser's site 140* (see ¶¶0087, 0088 and 0108 respectively). This objection is withdrawn because Applicant removed these reference signs from the specification.
8. Other previously made objections to the drawings are withdrawn.
9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

10. The disclosure was objected to; the previous objections are withdrawn.

Oath/Declaration

11. The oath or declaration is defective. Applicant made no attempt to correct this deficiency. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68, it requires proper signatures.

Claim Objections

12. Claims 10 and 11 were objected to. The matter is moot because claims 10 and 11 were canceled.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
14. Claims 1-20 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-20 were canceled, therefore the rejections are moot.

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15. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 recites the limitation "hyper text referral link" and there is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. Claims 1-20 were rejected under 35 U.S.C. 101. Claims 1-20 were canceled, therefore the rejections are moot.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the

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specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

21. Claims 21-27 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanborn et al., (U.S. 2002/0022996 A1) in view of Landau et al. (U.S. 2002/0082919 A1) and in view of Barber (U.S. 6,289,318 B1).

Claim 21:

Sanborn, as shown, discloses the following system limitations:

- *having a user connect to a website* (see at least Figure 6 and ¶0081),
- *having said user select a webpage* (see at least ¶0018, “the user has selected an image”),
- *having advertising delivered to said user* (see at least the Abstract, “the producer (a service provider) employing this method then prints and mails the product to the indicated address”),
- *having said advertising being printed through a printing means* (see at least ¶0020, “production on a suitable printing device”),
- *having said advertising being tangible print media* (see at least ¶0033, “a tangible product that is mailed”),

Sanborn discloses the ability to modify the promotion with advertiser images (see at least ¶0051), which reads on the following limitation with respect to modifying the advertisement. Sanborn does not specifically disclose a *Unique Identifier Code* as in the following limitation. However, Landau, as shown discloses a *Unique Identifier Code*:

- *having said advertising dynamically merged with an Unique Identifier Code which combines the Advertiser information and Coded Affiliate information to create uniquely identified advertising media that is delivered to the user electronically* (see at least ¶0050, “unique identifying code representing the referring webmaster”),

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Sanborn does not specifically disclose affiliates, and Landau does not specifically disclose a tier structure for compensating affiliates. However, Barber, as shown, discloses the following limitation:

- *having Tier-1 affiliate and Tier-2 affiliate where Tier-1 affiliates will get a portion of the commissions that are paid to the Tier-2 affiliate the result of sales and leads generated from Tier-2 affiliate's distribution of said code (see at least column 3, lines 27 and 36-38, Barber does not use the word "tier" in the disclosure, however Barber teaches a compensation structure that rewards multiple affiliates in a chain based on the relationship of the affiliates to each other and the revenue generating transaction),*

It would have been obvious to one having ordinary skill in the art at the time of the invention to add the unique codes of the Landau invention when using the Sanborn invention to modify the advertisements since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Further it would have been obvious to one having ordinary skill in the art at the time the invention was made to track additional tiers of affiliate referrals (i.e. referrals to the referring website) and to compensate affiliates based on their tier in the referral chain because this "provides compensation to more than the merchant operating the web site a consumer visits just before visiting the website of a paying merchant... [it provides] multi-level commissioned advertising" (Barber, Column 4, lines 54-59) and because it would provide a "robust mechanism to... compensate or credit merchants whose web sites were possibly instrumental in the consumer ultimately viewing the particular page" (Barber, column 3, lines 6-10). The final combination of these elements is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 22:

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The combination Sanborn/Landau/Barber discloses the limitations as shown in the rejection above. Further, Sanborn, as shown, discloses the following system limitation:

- *having said user contact the system through the Internet* (see at least Figure 6 and ¶0081).

Claims 23:

The combination Sanborn/Landau/Barber discloses the limitations as shown in the rejection above. Further, Sanborn, as shown, discloses the following system limitation:

- *having said user connect to the system through the use of a computer* (see at least ¶0037, “the computer process”).

Sanborn does not explicitly state that a user connects to the system via a computer, however, as shown, the system is a computer system and it relies on at least one computer in order to operate. It is therefore inherent that any user of the system connecting to the system for purposes of using it must connect through a computer.

Claim 24:

The combination Sanborn/Landau/Barber discloses the limitations as shown in the rejection above. Further, Sanborn, as shown, discloses the following system limitation:

- *said advertisement being uniquely identified* (see at least ¶0016),

Sanborn discloses “[t]he product could take many forms: a tangible product that is mailed: postcard, flyer, letter...” (see at least ¶0033). Sanborn does not specifically disclose:

- *tabbed flyers*.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the invention of Sanborn to create *tabbed flyers* as needed because *tabbed flyers* were well known and in general use at least by the time of this invention.

Claim 25:

The combination Sanborn/Landau/Barber discloses the limitations as shown in the rejection above. Further, Sanborn, as shown, discloses the following system limitation:

- *said advertisement being uniquely identified* (see at least ¶0016),

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Sanborn discloses “[t]he product could take many forms: a tangible product that is mailed: postcard, flyer, letter...” (see at least ¶0033). Sanborn does not specifically disclose:

- *business cards*.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the invention of Sanborn to create *business cards* as needed because customized *business cards* were well known and in general use at least by the time of this invention.

Claim 26:

The combination Sanborn/Landau/Barber discloses the limitations as shown in the rejection above. Further, Sanborn, as shown, discloses the following system limitation:

- *said advertisement being uniquely identified* (see at least ¶0016),

Sanborn discloses “[t]he product could take many forms: a tangible product that is mailed: postcard, flyer, letter...” (see at least ¶0033). Sanborn does not specifically disclose:

- *posters*.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the invention of Sanborn to create *posters* as needed because customized *posters* were well known and in general use at least by the time of this invention.

Claim 27:

The combination Sanborn/Landau/Barber discloses the limitations as shown in the rejection above. Further, Sanborn, as shown, discloses the following system limitation:

- *having said advertising being delivered through electronic mail* (see at least ¶0033, “a tangible product that is mailed:...;electronic communications”).

Claim 30:

The combination Sanborn/Landau/Barber discloses the limitations as shown in the rejection above. Sanborn does not specifically disclose the following limitation. However, Landau, as shown, discloses the following limitation:

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- *having said affiliate receiving compensation for products purchased as a result of the referral* (see at least ¶0052, affiliates providing referrals are compensated),

It would have been obvious to one having ordinary skill in the art at the time of the invention to add the unique codes of the Landau invention when using the Sanborn invention to modify the advertisements since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 31:

The combination Sanborn/Landau/Barber discloses the limitations as shown in the rejection above. Sanborn does not specifically disclose the following limitation. However, Landau, as shown, discloses the following limitation:

- *having said system having a clearinghouse function for maintaining said affiliate and advertiser's accounts* (see at least figure 2, affiliate server),

It would have been obvious to one having ordinary skill in the art at the time of the invention to add the unique codes of the Landau invention when using the Sanborn invention to modify the advertisements since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

- 22.** Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanborn et al., (U.S. 2002/0022996 A1) in view of Landau et al. (U.S. 2002/0082919 A1) and in view of Barber (U.S. 6,289,318 B1) and further in view of **Official Notice**.

Claims 28 and 29:

The combination Sanborn/Landau/Barber discloses the limitations as shown in the rejection above. The combination does not specifically disclose the following limitations. Examiner notes that the content of the advertisement does not patentably affect the scope of the invention and

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claims directed purely to the content of an advertisement do not merit patentable weight. Regarding the following limitations, Examiner takes **Official Notice** that hyper textual referral links and internet "cookies" are old and well known in the art. Further using "cookies" to identify web participants or to track web users' web history is also old and well known in the art.

- *having said advertisement including a hyper textual referral link*
- *having said hyper textual referral link or having an Internet "cookie" which transmits a unique code which identifies the affiliate and or Advertiser*

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to use add a hyper text link or a cookie to an advertisement electronically distributed by any of the teachings of Sanborn Landau or Barber individually or in concert with the Sanborn/Landau/Barber combination since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

23. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection. Examiner also notes the following. Applicant argued that *Barber does not disclose the same Tier structure as in the current invention nor does it disclose tier being used with a specific unique code and identifier*. Examiner maintains the Barber reference because Barber teaches at least an analogous tier structure. Examiner notes that the claims are directed to tiers generally, and that Barber teaches the broad disclosure of tiers presented in the claim. Further Examiner notes that Barber was neither relied upon to teach the unique identifier limitation in the rejection above, nor in the previous Office action.

Conclusion

- 24.** Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- 25.** A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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- 26.** Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
- 27.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
- 28.** Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

- 29.** Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
6 December 2008